



#35
S. Sand
7/23/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): K. Hachiya et al.
Appl. No.: 08/992,770
Conf. No.: 4200
Filed: December 17, 1997
Title: METHOD AND APPARATUS FOR AUTOMATIC SENDING OF E-MAIL
AND AUTOMATIC SENDING CONTROL PROGRAM SUPPLYING
MEDIUM
Art Unit: 2142
Examiner: Thong H. Vu
Docket No.: 114243-004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED

JUL 23 2003

RESPONSE TO OFFICE ACTION

Technology Center 2100

Sir:

This Response is submitted in response to the Office Action dated March 18, 2003. Claims 99-104, 116 and 123 are pending in the application. All of the claims stand and 123 rejected under 35 U.S.C. 103 as being obvious over U.S. Patent No. 6,067,568 to Lit et al. "in view of the obviousness in the art" [sic].

Regarding the rejection of the claims under 35 U.S.C. 103, Applicants respectfully traverse. Claim 99 calls for a method of providing an agent that includes randomly generating an agent parameter which is configured to determine a behavior of an agent adapted to deliver e-mail. The substance of this element bears repeating: A randomly generated agent parameter determines a behavior of the agent. In the present invention, parameters such as "action", "behavior", "character" and "appearance", relating to expression of the agent itself are set. By setting the parameter randomly, the agent will behave in unpredictable ways, exhibiting behaviors and performing functions unforeseen by the user. Li et al. teach nothing of the kind.

In contrast, parameters for controlling the "function" served by the agent are set in Li's system. Li discloses a method of providing an agent, which assists a user interacting with a particular service available on the computer system. A mail icon displayed in window 410 (Fig. 5) is used for accessing a mail agent for assisting a user by informing the user of messages editing mailing or subscription lists changing electronic mail parameters and so forth. The

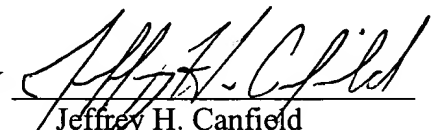
parameter's described by Li et al. relate to the functions performed by the agent rather than the behavior of the agent itself. At most, the additional references [Kotabe Kara, Will, Nakano, Aziz, Brust, Kasiviswanathan, Carr, Lee, and Shur] that teach at most random generation of various parameters. However, none of the parameters relate to the behavior of an animated agent, thus, the combined references fail to teach or suggest the claimed invention.

Turning to the rejection of the claims 100-104, Applicants again respectfully traverse. The claims stand rejected over Li in view of Okada. However, Okada is not prior art for purposes of examining the present application. Okada has a U.S. filing date of May 13, 1998. The present application was filed on December 17, 1997, and has priority based on two Japanese applications, one filed June 9, 1997, and the other filed December 20, 1996. Thus, the Okada reference does not qualify as prior art under 35 U.S.C. 102(e). Because Okada does not qualify as prior art against the present application, the combination of Li et al. and Okada to reject the pending claims is improper. Since Li et al. standing alone does not teach or suggest the claimed invention as a whole, the rejection under 35 U.S.C. 103 is improper and should be withdrawn.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY



Jeffrey H. Canfield

Reg. No. 38,404

P.O. Box 1135

Chicago, Illinois 60690-1135

Phone: (312) 807-4233

Dated: July 17, 2003

JUL 21 2003

TRANSMITTAL LETTER
(General - Patent Pending)

Docket No.
114243-004

In Re Application Of: K. Hachiya et al.

Serial No.
08/992,770

Filing Date
12/17/97

Examiner
Thong H. Vu

Group Art Unit
2152

Title: **METHOD AND APPARATUS FOR AUTOMATIC SENDING OF E-MAIL AND AUTOMATIC SENDING CONTROL PROGRAM SUPPLYING MEDIUM**

TO THE DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE:

Transmitted herewith is:

Response to Office Action (2 Pages); and Return Receipt Postcard.

RECEIVED

JUL 23 2003

Technology Center 2100

in the above identified application.

- ☒ No additional fee is required.
- ☐ A check in the amount of _____ is attached.
- ☒ The Director is hereby authorized to charge and credit Deposit Account No. **02-1818** as described below.
- ☐ Charge the amount of _____
- ☒ Credit any overpayment.
- ☒ Charge any additional fee required.


Signature

Dated: July 17, 2003

Jeffrey H. Canfield, Esq. (38, 404)
Bell, Boyd & Lloyd LLC
P.O. Box 1135
Chicago, Illinois 60690-1135
Telephone: (312) 807-4233

07/24/2003 SFORD1 00000001 021818 08992770
01 FC:1251 110.00 DA

I certify that this document and fee is being deposited on 07/17/03 with the U.S. Postal Service as first class mail under 39 C.F.R. 1.8 and is addressed to the Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.


Signature of Person Mailing Correspondence

Robert J. Buccieri

Typed or Printed Name of Person Mailing Correspondence

CC: